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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,121	11/30/2001	Richard R. Lunak	DB000970-000	4436

24122 7590 10/08/2003

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/998,121

Applicant(s)

LUNAK ET AL.

Examiner

Jeffrey A. Shapiro

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☒ Claim(s) 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 51 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 51 appears to reiterate the same language as Claim 50.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what "patient step" is being referred to in line 2.

4. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by step "d", "saving the at least one medical/surgical supply to the patient selected."

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-8, 10-12, 14-19, 21, 23-30, 32, 34-44, 46, 48, 52 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Wallace et al (US 6,564,121 B1). Wallace et al discloses the following.

As described in Claims 1, 15, 26, 37, 52 and 53;

1. dispensing and administering medications and issuing medical/surgical supplies using a device communicating with a central database (see abstract);
2. inputting information about a patient to the device for whom at least one medication may be dispensed and administered (see figure 16B, step 4);
3. dispensing the at least one medication to the patient by inputting information about the at least one medication to the device (see figure 16C, step (7));

4. saving the at least one medication to the patient selected (see figure 17C, button (1476);
5. inputting information about a patient to the device for whom at least one medical/surgical supply may be issued (see col. 1, lines 43-47, col. 10, lines 40-43 and col. 11, lines 54-65);
6. issuing the at least one medical/surgical supply to the patient by inputting information about at least one medical/surgical supply to the device (see figure 16C, step 7);
7. saving the at least one medical surgical supply to the patient selected (see col. 32, lines 20-38 and col. 33, lines 4-18);
  - 7a. recording the identity of the supply location (see figure 17C, noting that a "storage location", "PSY1" is identified in one of the fields of the "medication summary.");
  - 7b. a touch screen (420) (see figure 7 and col. 14, lines 1-5);
  - 7c. a radio communications unit (see col. 7, lines 41-47);

As described in Claims 2, 16, 27 and 38;

8. the saving step (4) results in the automatic deduction of the at least one medication from an inventory list saved on the central database (see col. 11, lines 64-67 and col. 12, lines 1-12);

As described in Claims 3, 17, 28 and 39;

9. the automatic deduction triggers an automatic reordering of the at least one medication from the central database if the automatic deduction

results in the inventory listing for that medication being less than a predetermined level assigned on the database for that medication (see col. 17, lines 54-65, noting that reorders are placed based upon inventory threshold stockout levels);

As described in Claims 4, 18, 29 and 40;

10. the saving step results in the automatic charging of the cost of the at least one medication to an invoice saved on the central database for the patient selected (see col. 11, lines 64-67 and col. 12, lines 1-12);

As described in Claims 5 and 41;

11. the saving step (7) results in the automatic deduction of at least one medical/surgical supply from an inventory list saved on the central database (see figures 18A-D);

As described in Claims 6 and 42;

12. the automatic deduction of claim 5 wherein the automatic deduction triggers an automatic reordering of the at least one medical/surgical supply from the central database if the automatic deduction results in the inventory listing for that medical/surgical supply being less than a predetermined level assigned on the database for that medical/surgical supply (again, note that inventory threshold stockout levels are used, which automatically trigger reorder when a particular lower level of inventory is reached);

As described in Claims 7 and 43;

13. regarding claim 6, wherein the saving step results in the automatic charging of the cost of the at least one medical/surgical supply to an invoice saved on the central database for the patient selected (see col. 11, lines 64-67 and col. 12, lines 1-12);

As described in Claims 8, 19, 30 and 44;

14. additionally comprising the step of logging the user onto the central database by inputting information into the device (see col. 18, lines 10-12);

As described in Claims 10, 21, 32 and 44;

16. the step of logging the user onto the central database is accomplished by typing a user ID and password on a menu of the device (see col. 18, lines 10-12);

As described in Claims 11 and 24;

17. the step of dispensing the at least one medication to the patient is done by scanning bar codes associated with the at least one medication (see col. 20, lines 20-29);

As described in Claim 12;

18. the step of dispensing the at least one medication to the patient is done by selecting the at least one medication from a menu on the device (see figure 29);

As described in Claim 14;

20. the step of issuing the at least one medical/surgical supply to the patient step is done by selecting the at least one medical/surgical supply from a menu on the device (see figure 16C, step 7);

As described in Claims 23, 25, 34-36 and 48;

21. the step of selecting a patient for whom at least one medical/surgical supply will be issued is done by selecting a patient from a menu of the device (note that it would have been obvious to select a patient from a menu);

21a. the step of issuing the at least one medical/surgical supply is done by selecting the at least one medical/surgical supply from a menu on the device (see figure 29);

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9, 13, 20, 22, 31, 33, 45, 47 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace et al (US 6,564,121 B1). Wallace et al discloses the following.

As described in Claims 9, 20, 31 and 45;



15. the step of logging the user onto the central database is accomplished by scanning a user barcode assigned to the user (note that this is a functional equivalent of inputting a login ID and that it would have been obvious to one skilled in the art to provide for this alternative format);

As described in Claims 13, 22, 33, 47, and 49-51;

19. the step of issuing the at least one medical/surgical supply to the patient is done by scanning bar codes associated with the at least one medical/surgical supply (see col. 20, lines 20-29);

19a. the bar code also provides the location of the supply (note that it would have been obvious for one ordinarily skilled in the art to provide the location in the form of a bar code);

### ***Conclusion***

9. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. An explanation of the relevance of the three items provided for in the information disclosure statement, dated 3/10/03. These three items are the "Functional Specification" and "Test Plan" for the AcuScanRX System, Version 2.1 as well as the "AcuScan-Rx Bible. As such, the consideration of these references has been suspended until further information is provided.

Should there be any questions regarding this request or any other aspect of the action, Applicant's representative is encouraged to contact the Examiner.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ahlin et al and Joao are cited as examples of drug management/administration systems.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Jeffrey A. Shapiro  
Examiner  
Art Unit 3653

September 29, 2003



DONALD P. WALSH  
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